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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,792	02/24/2004	Kishio Shibato	ORI-17098.001	2181

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EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/784,792

Applicant(s)

SHIBATO ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/7/07 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed February 7, 2007 has been entered. Claims 1-9 are deleted. Claims 10 and 20 are amended. Now, Claims 10-21 are pending.

2. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC § 102

3. Claims 10-21 are rejected under 35 USC 102(b) as being unpatentable over Yamamoto (US 6 103 387).

Yamamoto teaches a coating composition comprising component A) can be component A') (col. 25, lines 49-67) that is prepared by polymerizing a monomer mixture comprising a **hydroxyl** containing monomer (col. 27, lines 5-17), an

epoxy containing monomer (col. 28, lines 9-28), a **carboxyl** containing monomer (col. 27, lines 18-42), etc. The amounts of the hydroxyl containing monomers and the epoxy containing monomers are described in col. 26, lines 52-60 and col. 28, lines 1-8. Yamamoto is silent on the polymerizing the monomer mixture in the presence of component C). However, these claims are product-by-process claims. “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process” In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

For Applicants’ argument (Remarks, page 10, 3rd paragraph to page 12, 3rd paragraph), Examiner disagrees because of the following reason: Since Applicants’ organosilicate is non-radical polymerizable, it would not involve in the radical polymerization of the hydroxyl containing monomers and the epoxy containing monomers. As such, whether the Yamamoto’s radical polymerizable monomers are polymerized in the presence of the non-radical polymerizable organosilicate or not appears to be irrelevant, unless Applicants can show otherwise. Applicants are reminded that the alleged unexpected results in Applicants’ specification (page 28,

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line 26 to page 29, line 14) is merely an opinion, not evidence. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) Attorney statements which are not evidence and which must be supported by an appropriate **affidavit** or **declaration**. See MPEP 2144 (I).

4. Rejection of Claims 10-21 under 35 USC 102(b) as being anticipated by Nambu (EP 1 013 730, US 6 316 572) is maintained because the rejection is adequately set forth in paragraph 7 of Paper No. 111106. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 13, last paragraph to page 14, 1st paragraph), Examiner disagrees because of the following reasons: First, Nambu's component (x) is derived from an epoxy-containing vinyl monomer and a hydroxyl-containing vinyl monomer. (col. 4, line 59 to col. 6, line 30 and col. 7, lines 35-62) The amounts of the epoxy-containing vinyl monomer and the hydroxyl-containing vinyl monomer are described in col. 6, lines 31-38 and col. 7, line 66 to col. 8, line 7. As such, the component (x) reads on Applicants' acrylic resin structure part. Second, regarding whether or not the radical polymerization

for preparing the acrylic resin being carried out in the presence of the non-radical polymerization, Examiner's position, supra, is applicable here.

5. Rejection of Claims 10-15 and 18-21 under 35 USC 102(b) as being anticipated by JP847 (JP 11-116847) is maintained because the rejection is adequately set forth in paragraph 8 of Paper No. 111106. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 14, last paragraph to page 15, 1st paragraph), Examiner's position, supra, is applicable here.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval

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(PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

April 14, 2007



Kuo-Liang Peng
Primary Examiner
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